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DOCKET NO.: **19 to 0088

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Goodman, et al.**

Serial No.: **09/941,072**

Filing Date: **August 28, 2001**
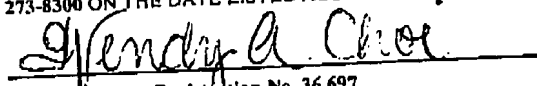
For: **Tracking Files of Storage Media and Enabling Users to Quickly Associate Such Files with the Storage Media on Which They are Stored**

Confirmation No.: **5656**

Group Art Unit: **2161**

Office: **Etienne P. LeRoux**

CERTIFICATE OF FACSIMILE TRANSMISSION

DATE: November 23, 2007

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Wendy A. Choi, Registration No. 36,697

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Sir:

APPELLANTS' BRIEF PURSUANT TO 37 C.F.R. § 41.37

This *second corrected* Appeal Brief is submitted in response to the second Notification of Non to Compliant Appeal Brief mailed September 14, 2007 in the above to identified application. Appellants filed a first corrected Appeal Brief on September 10, 2007 in response to the first Notification of Non to Compliant Appeal Brief mailed August 10, 2007. This second corrected Appeal Brief is being filed in support of Appellant's appeal from the rejections of claims 1 to 43 dated August 31, 2006. A Notice of Appeal was filed on January 3, 2007.

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1. REAL PARTY IN INTEREST

The real parties in interest are:

(1) Assignee: Polytechnic University, 6 Metro Tech Center, 6 Metrotech Center, Brooklyn, New York 11201, by virtue of an assignment from the inventors recorded at 012130/0254 on August 28, 2001; and

(2) Licensee: Intellectual Ventures Holding 19, LLC, 502 East John Street, Carson City, Nevada 89706, by virtue of a license agreement from the assignee recorded at 019605/0045 on July 27, 2007.

2. RELATED APPEALS AND INTERFERENCES

No related appeals or interferences are pending. See appendix entitled RELATED PROCEEDINGS APPENDIX.

3. STATUS OF CLAIMS

Pending	:	Claims 1 to 43
Rejected	:	Claims 1 to 43
Objected to	:	None
Allowed	:	None
Withdrawn	:	None
Appealed	:	Claims 1 to 43.

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The appealed claims are listed in the appendix entitled CLAIMS APPENDIX.

4.   STATUS OF AMENDMENTS

No claim amendments were filed subsequently to Final Rejection.

5.   SUMMARY OF CLAIMED SUBJECT MATTER

Various embodiments of the present invention may be used to (i) associate a label, such as a bar code label, with a storage medium and (ii) associate the label with the contents of the storage medium. In this way, given a storage medium, a user can determine its contents, without needing to read the storage medium, by reading the label. Similarly, given a file, a user can determine the label of the storage medium on which the file is stored. The labels of various storage media can be quickly read, and an indication of whether or not the storage medium includes the file can be provided to a user.

As required under 35 U.S.C. § 41.37(c)(v), appellants are providing a concise explanation of the subject matter defined in each of the independent claims involved in the appeal (namely, claims 1, 15, 20, and 35), which refer to the specification by page and line number, and to the drawing, if any, by reference characters:

Independent claim 1 is directed to a method for assigning a unique label to a storage medium, for use by a read/write machine, the method comprising:

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a)   determining whether or not the storage medium has been assigned a unique volumene label and a unique storage medium label, the unique storage medium label uniquely identifying the storage medium;

Figure 3, 310; Figure 6; page 16, line 32 through page 17, line 30; and page 25, line 8 through page 26, line 8

b)   if the storage medium has not been assigned a unique volume label and a unique storage medium label, then

      (i)   determining a unique storage medium label for the storage medium,

Figure 3, 315; page 17 line 30 through page 18, line 3; and page 26, lines 6 to 17

      (ii)   determining a unique volume label for the storage medium,

Figure 3, 315; Figure 6, 670b; page 17, line 30 through page 18, line 3; and page 19, lines 1 to 14.

      (iii)   writing the unique volume label onto the storage medium, and

Figure 3, 320; Figure 6, 670b; page 18, lines 3 to 14; and page 26, lines 17 to 22

      (iv)   providing a command to generate a label based on the unique storage medium label, the label to be associated with the storage medium; and

Figure 3, 325; Figure 6, 670a and 680; page 18, lines 3 to 11; and page 26, lines 12 to 17

c)   updating a database based on files, if any, added to or deleted from the storage medium.

Figure 3, 330; Figure 6, 650 and 660; page 18, lines 14 to 16; and page 26, lines 2 to 4)

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    __Independent claim 15__ is directed to a method for matching file parameters with one or more storage media, each of the one or more storage media having an associated label, the method comprising:

a)   accepting one or more search parameters selected from a group of parameters consisting of (A) file name, (B) file size, (C) file author, and (D) file type;

Figure 4, 440 and 445; Figure 9, 930 and 940; page 21, lines 19 to 23; and page 29, lines 4 to 18

b)   generating a query based on the search parameters;

Figure 4, 450; Figure 9, 950; page 21, line 29 to 32; and page 29, lines 18 to 20

c)   accepting one or more records returned in response to the query generated;

Figure 4, 455; Figure 9, 960; page 22, lines 2 to 5; and page 29, lines 21 to 27

d)   rendering information associated with each of the one or more records accepted, the information rendered being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted.

Figure 4, 460; page 22, lines 5 to 8; and page 29, line 27 through page 30, line 7.

    __Independent claim 20__ is directed to an apparatus for assigning a unique label to a removable storage medium, the apparatus comprising:

Figure 1; page 8, lines 5 to 24; Figure 2; page 15, lines 1 to 32; Figure 5; and page 22, line 26 to page 23, line 17

a)   means for reading files from and/or writing files to a removable storage medium;

Figure 1, 114 and 16; Figure 2, 216 and 218; and page 10, line 18 through page 11, line 16

b).   means for generating a label;

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Figure 2, 224 and 226; page 10, lines 25 to 29; and page 15, lines 13 to 17

c) means for determining whether or not the removable storage medium has been assigned a unique volume label and a unique storage medium label, the unique storage medoum label uniquely identifying the storage medium;

Figure 2, 214 and 216; and page 11, lines 5 to 14

d) means, if the storage medium has not been assigned a unique volume label and unique storage medium label, for

(i) determining a unique storage medium label,

(ii) determining a unique volume label,

(iii) instructing the means for reading and/or writing files to write the unique volume label onto the storage medium, and

(iv) providing a command to generate a label based on the unique storage medium label , to the means for generating a label; and

Figure 2, 214 and 216; and page 11, lines 5 to 14

e) a database, wherein the database is updated based on files added to or deleted from the removable storage medium.

Figure 2, 220 and 222; page 10, lines 18 to 25; and page 11, line 18 through page 12, line 11

Independent claim 35 is directed to an apparatus for matching file parameters with one or more storage media, each of the one or more storage media having an associated label, the apparatus comprising:

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Figure 1; page 8, lines 5 to 24; Figure 2; page 15, lines 1 to 32; Figure 5; and page 22, line 26 through page 23, line 17

a) a user input for accepting one or more search parameters selected from a group of parameters selected from a group of parameters consisting of (A) file name, (B) file size, (C) file author, and (D) file type;

Figure 2, 246; and page 13, lines 15 to 19

b) means for generating a query based on the accepted one or more search parameters;

Figure 2; and page 13, line 15 to page 14, line 24

c) means for accepting one or more records returned in response to the query generated;

page 13, line 15 to page 14, line 24

d) means for rendering information associated with each of the one or more records accepted, the information rendered being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted, wherein the label is provided on the storage medium without storing it on the storage medium.

Figure 2, 244, 248; Figure 5, 534; and page 13, lines 22 to 29

As required under 35 U.S.C. § 41.37(c)(v), for each independent claim involved in the appeal (claims 1, 15, 20, and 35) and for each dependent claim argued separately,[1] appellants are required to identify every means plus function and step plus function and the structure, material, or acts described in the specification as corresponding to each claimed function with

---

[1] Appellants have argued several dependent claims separately, namely, claims 9, 13, 14, 16 to 19, 28, 36 to 39, and 42. However, none of these dependent claims includes means plus function or step plus function. Therefore, the table only includes the means plus function or step plus function for the independent claims that include this type of feature.

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reference to the specification by page and line number, and to the drawing, if any, by reference characters:

Claim	Means plus function or step plus function	Structure, material, or acts described in specification as corresponding to each claimed function	Citation in specification and drawings
20 (a)	means for reading files from and/or writing files to a removable storage medium	a floppy disk drive a CD ROM drive, a ZIP drive a DVD drive	Figure 1, 114 and 16; Figure 2, 216 and 218; and page 10, line 18 to page 11, line 16
20 (b)	means for generating a label	label generation operation (*e.g.*, Codabar from Azalia of Seattle, WA) bar-coding software	Figure 2, 224 and 226; page 10, lines 25 to 29; page 11, lines 12 to 16 and page 15, lines 13 to 17
20 (c)	means for determining whether or not the removable storage medium has been assigned a unique volume label and a unique storage medium label, the unique storage medoum label uniquely identifying the storage medium	control operations 214 for controlling a device (*e.g.*, a disk drive(s)) 216 control operations 214 for controlling the read/write device 216 may be effected using available device drivers, often included in the Windows family of operating systems from Microsoft a read/write device (*e.g.*, a floppy disk drive) 216 may communicate to its controller 214	Figure 2, 214 and 216; and page 11, lines 5 to 14
20 (d)	means, if the storage medium has not been assigned a unique volume label and unique storage medium label, for (i) determining a unique storage medium label, (ii) determining a unique volume label,	control operations 214 for controlling a device (*e.g.*, a disk drive(s)) 216 control operations 214 for controlling the read/write device 216 may be effected using available device drivers, often included in the Windows family of operating systems from Microsoft a read/write device (*e.g.*, a floppy disk drive) 216 may communicate to its controller 214	Figure 2, 214 and 216; and page 11, lines 5 to 14

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Claim	Means plus function or step plus function	Structure, material, or acts described in specification as corresponding to each claimed function	Citation in specification and drawings
	(iii) instructing the means for reading and/or writing files to write the unique volume label onto the storage medium, and (iv) providing a command to generate a label based on the unique storage medium label , to the means for generating a label		
35 (b)	means for generating a query based on the accepted one or more search parameters	The content tracking (non-base) operation(s) 242 may also function to accept search parameters from a user. More specifically, the user interface operation(s) 244 may prompt the user to input information via the input device(s) 246. The accepted parameters may then be used to generate a search query used by the database management operation(s) 254 to find matching records or items in the database instance 256. The results will indicate which storage medium or storage media store the file(s) with parameter(s) matching the search query. Such results can be used to help the user locate the storage medium with the desired content (files) in a number of ways. Alternatively, such operations, or a separate instance of such operations, may be performed on the read/write machine 210. For example, if the label (Recall 228) includes a human-readable visual cue	Figure 2; and page 13, line 15 to page 14, line 24

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Claim	Means plus function or step plus function	Structure, material, or acts described in specification as corresponding to each claimed function	Citation in specification and drawings
		(Recall 237), that visual cue may be displayed to the user via output device 248. The user may then use this information to quickly locate the desired storage medium based on the human-readable visual cue included on the label associated with (e.g., affixed to) the storage medium. One exemplary visual cue could include a sequence of n shapes of m possible colors. Therefore, if $m=8$ (e.g., white, black, purple, blue, green, yellow, orange, red) and $n=2$ or 3, 64 or 512 (m^n) labels, respectively, could be provided with unique visual cues. These numbers could be increased by varying the type of shape. For example, if there are four possible shapes (e.g., circle, square, triangle, star), $(8=4)^n$ labels could be provided with unique visual cues. The media type can be rendered to the user via the output device 248. The user may quickly scan successive candidate storage media until a match with the search result(s) is indicated. For example, a non-match may be audibly indicated by a lower frequency buzz, while a match may be audibly indicated by a higher frequency beep.	
35 (c)	means for accepting one or more records returned in response to the query generated	The content tracking (non-base) operation(s) 242 may also function to accept search parameters from a user. More specifically, the user interface operation(s) 244 may prompt the user to input information via the input device(s) 246. The accepted parameters may then be used to generate a search query used by the database management operation(s) 254 to find matching records or items in the	page 13, line 15 to page 14, line 24

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Claim	Means plus function or step plus function	Structure, material, or acts described in specification as corresponding to each claimed function	Citation in specification and drawings
		database instance 256. The results will indicate which storage medium or storage media store the file(s) with parameter(s) matching the search query. Such results can be used to help the user locate the storage medium with the desired content (files) in a number of ways. Alternatively, such operations, or a separate instance of such operations, may be performed on the read/write machine 210. For example, if the label (Recall 228) includes a human-readable visual cue (Recall 237), that visual cue may be displayed to the user via output device 248. The user may then use this information to quickly locate the desired storage medium based on the human-readable visual cue included on the label associated with (e.g., affixed to) the storage medium. One exemplary visual cue could include a sequence of n shapes of m possible colors. Therefore, if m=8 (e.g., white, black, purple, blue, green, yellow, orange, red) and n=2 or 3, 64 or 512 (m^n) labels, respectively, could be provided with unique visual cues. These numbers could be increased by varying the type of shape. For example, if there are four possible shapes (e.g., circle, square, triangle, star), $(8=4)^n$ labels could be provided with unique visual cues. The media type can be rendered to the user via the output device 248. The user may quickly scan successive candidate storage media until a match with the search result(s) is indicated. For example, a non-match may be	

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Claim	Means plus function or step plus function	Structure, material, or acts described in specification as corresponding to each claimed function	Citation in specification and drawings
		audibly indicated by a lower frequency buzz, while a match may be audibly indicated by a higher frequency beep.	
35 (d)	means for rendering information associated with each of the one or more records accepted, the information rendered being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted, wherein the label is provided on the storage medium without storing it on the storage medium	output device(s) 248 output device(s) 534 (such as a video monitor, a printer, and/or a speaker(s))	Figure 2, 244, 248; Figure 5, 534; and page 13, lines 22 to 29

6.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for review are whether or not:

a.   claims 1 to 14 are enabled under 35 U.S.C. 112, first paragraph;

b.   claims 1 to 8, 10 to 15, 19 to 27, 29 to 35 and 39 to 42 are anticipated under 35 U.S.C. § 102(e) by US-B-6,483,602 ("the Haneda patent");

c.   claims 9 and 28 are obvious under 35 U.S.C. § 103(a) over the Haneda patent in view of US-A-4,864,616 ("the Pond patent");

d.   claims 16 to 18 and 36 to 38 are obvious under 35 U.S.C. § 103(a) over the Haneda patent in view of US-A-5,971,279 ("the Raistrick patent"); and

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e.   claim 43 is obvious under 35 U.S.C. § 103(a) over the Haneda patent.

7. ARGUMENT

The appellants respectfully request that the Board reverse the final rejection of claims 1 to 43 in view of the following.

a. Claims 1 to 14 are enabled under 35 U.S.C. § 112, first paragraph

Claims 1 to 14 are rejected under 35 U.S.C. 112, first paragraph, as allegedly lacking enablement. The appellants respectfully request that the Board to reverse this ground of rejection in view of the following.

The Office contends that although claim 1 recites "determining whether or not the storage medium has been assigned a unique value label and a unique label identifier," the specification does not include an enabling disclosure of this feature (see Paper No. 8/24/06, page 2). The Office also contends that the specification did not enable making and using a "unique storage medium label" (see Paper No. 8/24/06, page 2). The Office interpreted the claimed unique volume label and the claimed unique storage medium label as being one in the same thing (Paper No. 08/24/06, page 3).

The teachings of the specification, as they would be understood by one skilled in the art, as well as relevant case law, are now introduced.

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MPEP § 2164.01 correctly states that the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent, coupled with information known in the art, without undue experimentation. One skilled in the art could determine whether or not the storage medium has been assigned a unique volume label and a unique label identifier (or a unique storage medium label) without undue experimentation in light of the teachings of the specification, the level of skill in the art, and the predictable nature of data storage.

Those skilled in the art would have knowledge of various storage medium operations, such as reading, writing, formatting, etc. Further, such operations are predictable. As for the specification, it states, in pertinent part:

> Basically, *when files are first written to a machine to readable medium* 218, the content tracking base operation(s) 212 will, based on state information 264, *associate a _unique Identifier_ (and a unique volume label) with the machine to readable medium* 218. Further, when files are first written to the machine to readable medium 218, the content tracking base operation(s) 212 will also provide *_unique information_ to the label generation operation(s) 224 for having the printer 226 generate a _label_* (such as a bar code label for example) 228. In alternative embodiments, other types of machine to readable labels can be generated instead.

Page 11, lines 5 to 16 (emphasis added).

> In the following, the term "*_unique volume label_*" uniquely identifies a storage medium, and may be *written onto the storage medium*. Therefore, if the storage medium is a diskette, the unique volume label may be a unique label written onto the diskette by a floppy disk drive, and that may be subsequently read by a floppy drive. The term "*label*" also *_uniquely identifies_ a storage*

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medium, but is associated with (e.g., affixed to) the storage medium. Therefore, if the storage medium is a diskette, the label may be a bar code label affixed to the case of the diskette, and that may be subsequently read by a bar code reader. Although the unique volume label, and the label of a given storage medium may be the same, or encode the same information, this is not necessarily the case.

Referring back to conditional branch point 310, recall that *it is determined whether or not a storage medium is new. This may be done, for example, by comparing the unique volume label, if any, of the storage medium, with stored state information* (Recall, *e.g.* , 264 of Figure 2.). *If the storage medium is determined to be new, the method 212' continues to block 315 where a unique label and a unique volume label are determined.* For example, these labels may be determined from state information 264, such as a counter that is incremented for each new storage medium for example. Then, as indicated by blocks 320 and 325, the unique volume label is written onto the storage medium, and a command to print (or otherwise generate) a unique label associated with the storage medium is generated. Referring back to Figure 2, this command may be passed to the label generation operation 224. The user may then associate the printed unique label with the storage medium (*e.g.* , by affixing it to a so to called "jewel to box" case or cartridge used to hold the storage medium). Alternatively, the unique label may be automatically associated with the storage medium (i.e., without (further) user intervention) in another way. As indicated by block 330, the database may be updated to reflect saved or deleted files. For example, this may be done by adding a new record (or item), or by altering an appropriate existing record (or item), when a file is saved, or by removing an appropriate record (or item) when a file is deleted. The key of the record (or item) may correspond to that used for the unique label, or the unique volume label, though this is not necessarily true. As indicated by optional block 335, a synchronization may be effected (Recall, *e.g.* , operations 262 and 258 of Figure 2.) if possible. The method 212' may then be left via RETURN node 360.

Referring back to conditional branch point 310, if the storage medium is determined not to be new, the method 212' continues to block 330, which was just described above.

Naturally, there are many ways to assign unique volume labels. One exemplary way is to maintain a sequence count which may be initialized (*e.g.* , to "1000") when the content tracking

application is installed onto the read/write machine (*e.g.* , a personal computer). The unique volume label may be written by launching a DOS command such as "label a: {sequence count value}" within a JAVA application. When determining whether a current disk has a valid unique volume label, the (unique) volume label can be read and compared with the sequence count. If the read (unique) volume label is greater than the value of the sequence count (or less than the value of the initial sequence count), or is not an x to digit (*e.g.* , 4 to digit) number, then it may be deemed invalid.

Page 17, line 10 through page 19, line 14 (emphasis added).

Assigning and tracking one or more unique identifiers for each of a plurality of storage media are certainly with the skill set of those skilled in the art. More specifically, as can be appreciated from the foregoing excerpts, the first time files are written to a storage medium, a "unique volume label" might be written onto the storage medium and a "label" might be associated with (*e.g.* , affixed to) the storage medium. The "label" is obviously generated from some data. The appellants chose to call this a "unique label identifier".[2]

Since both the unique storage medium label and unique volume label are determined when the storage medium has not been assigned a unique volume label and a unique storage medium label, the absence of either or both of these from a storage medium can be used to indicate the storage medium has not been assigned a unique volume label and a unique storage medium label. Since determining whether or not a storage medium includes a volume label can be accomplished by those skilled in the art, it follows logically that those skilled in the art can determine whether or not the storage medium has not been assigned a

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[2] MPEP § 2173.01 correctly notes that appellants are their own lexicographers and may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought.

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unique volume label and a unique label identifier. Consequently, the rejection under 35 U.S.C. § 112, first paragraph, is improper and should be withdrawn.

In the final Office Action, the Office cites paragraph [0071] of the present application which discusses scanning a storage medium label and asserts that it is unclear how a user scans a non to existent label (see Paper No. 08/24/06, page 12). The "show contents" example cited by the Office occurs after the label has been added. Consequently, the part of the specification cited by the Office is not relevant to the issue of enablement. The fact that the Office can cite a section of the specification not relevant to the issue of enablement does not negate the fact that the appellants has demonstrated that (relevant portions of) the specification enables those skilled in the art to make and use the claimed invention.

As can be appreciated from the foregoing excerpts, the unique storage medium label uniquely identifies the storage medium. Accordingly, claim 1 and its dependent claims are enabled. Consequently, the appellants respectfully request that the Board reverse this ground of rejection of claims 1 to 14 under 35 U.S.C. § 112, first paragraph.

    b.   **Claims 1 to 8, 10 to 15, 19 to 27, 29 to 35 and 39 to 42 are novel under 35 U.S.C. § 102(e) over the Haneda patent**

Claims 1 to 8, 10 to 15, 19 to 27, 29 to 35 and 39 to 42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the Haneda patent. The appellants respectfully request that the Board reverse this ground of rejection in view of the following.

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The Haneda patent concerns a film image management system. Referring to Figure 10 of the Haneda patent, undeveloped film is developed and read, and image information is saved to a laboratory disk, printed, and recorded (perhaps in reduced form) on a user disk. Labels with an identification code may be printed and affixed to one or both of a film roll container or envelope, and the user disk (see, *e.g.* , Figures 3 to 7).

In addition to, or instead of, affixing the bar code label to the disk, the identification code may be stored on the disk. Examples of the identification code are listed on column 15, lines 14 to 48. The label may be provided with human comprehensible characters, symbols, and/or figures (see, *e.g.* , Figures 8 and 9).

Note that the media contents of the developed film, to which an identification code label is applied, are fixed. Similarly, the media contents of the user disk, to which an identification code label is applied, are intended to be fixed.

The identification code and frame identifiers may be used when ordering extra prints (*e.g.* , via a communications network or via a paper order form). For example, such extra prints may be ordered while the user is viewing the images using a playback program. Specifically, the laboratory can use the identification code and frame identifier to retrieve images that the user wants extra prints of (see, *e.g.* , column 5, lines 29 to 42).

Claims 1 to 8, 10 to 12, 20 to 27, 29 to 34, 40 and 41

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Independent claims 1 and 20 are not anticipated by the Haneda patent because the Haneda patent does not disclose, teach, or suggest an act of (or means for) determining whether or not the storage medium has been assigned a unique volume label and a unique storage medium label (the unique storage medium label uniquely identifying the storage medium), and if the storage medium has not been assigned a unique volume label and a unique storage medium label, then determining *both* a unique storage medium label for the storage medium, *and* a unique volume label for the storage medium, writing the unique volume label onto the storage medium, and providing a command to generate a label based on the unique storage medium label, the label to be associated with the storage medium.

In the rejection of claims 1 to 14 under 35 U.S.C. § 112, first paragraph, the Examiner noted that he assumed that the unique volume label and the unique storage medium label were one and the same thing (see Paper No. 08/24/06, page 3). In the rejection of these claims as being anticipated under the Haneda patent, the Office cites column 4, lines 8 to 15, as well as column 19, lines 50 to 65 (see Paper No. 08/24/06, page 4), which describe storing an identification code on film, a user recording medium, and a laboratory recording medium, and affixing a bar code label to developed film.

The appellants respectfully, but strongly submit that the Office is improperly ignoring features of the claimed invention that distinguish it over the Haneda patent. Specifically, merely affixing or storing an identification code to a storage medium does *not* teach *determining whether or not the storage medium has been assigned* a unique volume label and a unique storage medium label (the unique storage medium label uniquely identifying the

storage medium). As discussed above, in the Haneda patent, undeveloped film is developed and read, and image information is saved to a laboratory disk, printed, and recorded (perhaps in reduced form) on a user disk. Labels with an identification code may be printed and affixed to one or both of a film roll container or envelope, and the user disk. Note that the media contents of the developed film to which an identification code label are fixed. Similarly, the media contents of the user disk to which an identification code label are intended to be fixed. *That is, the user disk is intended to be written with reduced or original sized images, and perhaps the identification code, once. Consequently, there would be no need to determine whether or not this has been written on the user disk to to when the laboratory first stores the image data on the user disk, such information has not already been written and/or applied to the disk.*

Independent claims 1 and 20 are not anticipated by the Haneda patent for at least the foregoing reason. Since claim 2 to 8, 10 to 12 and 40 depend, either directly or indirectly, from claim 1, and since claims 21 to 27, 29 to 34 and 41 depend, either directly or indirectly, from claim 20, these claims are similarly not anticipated by the Haneda patent.

Claims 13 and 14

First, since claim 13 depends, indirectly, from claim 1, it is not anticipated by the Haneda patent for at least the reason discussed above with reference to claim 1. Also, dependent claim 13 further recites that accepted information read from a label associated with the storage medium is read by a handheld device, and the information about accepted records

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(accepted in response to a request from a database instance using a database key converted from the accepted information) is rendered on the handheld device. The Office cited paragraph 39 of the Haneda patent as teaching this feature (see Paper No. 08/24/06, page 6). However, the appellants have not found this feature in the Haneda patent, and previously requested that that the Office cite the column and line numbers and/or Figure and reference numbers of the Haneda patent alleged to teach this feature. Nonetheless, the Office still only cited paragraph 39 of the Haneda patent. Thus, claim 13 is not anticipated by the Haneda patent for at least this additional reason.

Since claim 14 depends from claim 13, it is similarly not anticipated by the Haneda patent.

Claims 15, 19, 35, 39 and 42

Independent claims 15 and 35 are not anticipated by the Haneda patent because the Haneda patent does not teach an act of (or means for) accepting one or more search parameters selected from a group of parameters consisting of (A) file name, (B) file size,(C) file author, and (D) file type. The Office is apparently characterizing the album name in the Haneda patent as the claimed "file name" (see Paper No. 08/24/06, page 7), which cites column 54, lines 35 to 40). The Office then cites column 4, lines 40 to 48, column 5, lines 25 to 30 and column 9, lines 45 to 60 as teaching rendering information associated with each of the one or more records accepted, the information rendered being related to the label associated with the storage medium storing one or more files identified with the one or more

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records accepted, wherein the label is provided on the storage medium without storing it on the storage medium (see Paper No. 08/24/06, page 7).

However, an album is a collection of image data from one or more rolls of film (see, e.g. , column 51, lines 63 to 65 and column 52, lines 40 and 41 of the Haneda patent). If the album name is input in the Haneda patent, information associated with each of the one or more records accepted, and being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted, is not rendered. Accordingly, independent claims 15 and 35 are not anticipated by the Haneda patent. Since claims 19 and 42 depend from claim 15, and since claim 39 depends from claim 35, these claims are similarly not anticipated by the Haneda patent.

Accordingly, the appellants respectfully request that the Board reverse this ground of rejection of claims 1 to 8, 10 to 15, 19 to 27, 29 to 35 and 39 to 42 under 35 U.S.C. § 102(e) over the Haneda patent.

c. **Claims 9 and 28 are not obvious under 35 U.S.C. § 103(a) over the Haneda patent in view of the Pond patent**

Claims 9 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Haneda patent in view of the Pond patent. The appellants respectfully request that Board reverse this ground of rejection in view of the following.

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Since the purported teachings of the Pond patent fail to compensate for the deficiencies of the Haneda patent with respect to claims 1 and 20 as discussed above, even assuming, arguendo, that one skilled in the art would have been motivated to combine the Haneda and Pond references as proposed by the Office, such a combination would fail to render the invention of claims 1 and 20, and therefore of claims 9 and 28, unpatentable.

Accordingly, the appellants respectfully request that the Board reverse this ground of rejection of claims 9 and 28 under 35 U.S.C. § 103(a) as obvious over the Haneda patent in view of the Pond patent.

e. **Claims 16 to 18 and 36 to 38 are not obvious under 35 U.S.C. § 103(a) over the Haneda patent in view of the Raistrick patent**

Claims 16 to 18 and 36 to 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Haneda patent in view of the Raistrick patent. The appellants respectfully request that the Board reverse this ground of rejection in view of the following.

Claims 16 and 36

First, since the purported teachings of the Raistrick patent fail to compensate for the deficiencies of the Haneda patent with respect to claims 15 and 35 as discussed above, even assuming, arguendo, that one skilled in the art would have been motivated to combine the Haneda and Raistrick patents as proposed by the Office, such a combination would fail to render the invention of claims 15 and 35, and therefore of claims 16 and 36, unpatentable.

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Second, claims 16 and 36 further recite that the labels are machine to readable labels, and acts of (or means for) accepting information read from the machine to readable labels, and if the accepted information read from the machine to readable labels matches information associated with any one of the one or more records accepted, then generating a first indicator, said first indicator able to be perceived by humans. Under the scanning in the Raistrick patent, if a scanned bar code is found, an associated message is played, while if the scanned bar code is not found, a memo may be recorded (see Figure 2, steps 64, 66 and 68, and column 4, lines 39 to 55) Such an indication of whether or not a scanned bar code is found neither teaches, nor suggests, indicating whether or not a scanned label affixed to a storage medium includes a file being searched for. Thus, the Raistrick patent does not teach what the Office alleges.

Furthermore, under the search operation in the Raistrick patent does not employ a bar code scan, but rather allows a user to move through (and perhaps erase) recorded memos (see Figure 2, step 104 and column 5, lines 4 to 12). Thus, the Raistrick patent does not disclose, teach, or suggest what the Office alleges.

Moreover, the Raistrick patent is concerned with helping the visually impaired. One skilled in the art would not have been motivated to use such techniques in the context of an imaging system, such as that described in the Haneda patent, which uses thumbnails of images.

Thus, claims 16 and 36 are not rendered obvious by the Haneda and Raistrick patents for at least these additional reasons.

Claims 17, 18, 37 and 38

First, since the purported teachings of the Raistrick patent fail to compensate for the deficiencies of the Haneda patent with respect to claims 15 and 35 as discussed above, even assuming, arguendo, that one skilled in the art would have been motivated to combine the Haneda and Raistrick patents as proposed by the Office, such a combination would fail to render the invention of claims 15 and 35, and therefore of claims 17, 18, 37 and 38, unpatentable. Similarly, since claims 17 and 37 depend from claims 16 and 36, respectively, and since claims 18 and 38 depend from claims 17 and 37, respectively, these claims are not rendered obvious by the Haneda and Raistrick patents for at least the reasons discussed above with reference to claims 16 and 36.

Second, claims 17 and 37 further recite an act of (or means for) generating a second indicator, able to be perceived by humans, if the accepted information read from the machine to readable labels does not match information associated with any one of the one or more records accepted. As discussed above, under the scanning in the Raistrick patent, if a scanned bar code is found, an associated message is played, while if the scanned bar code is not found, a memo may be recorded (see Figure 2, steps 64, 66 and 68, and column 4, lines 39 to 55). Such an indication of whether or not a scanned bar code is found neither teaches,

nor suggests, indicating whether or not a scanned label affixed to a storage medium includes a file being searched for. Thus, the Raistrick patent does not teach what the Office alleges.

Furthermore, under the search operation in the Raistrick patent does not employ a bar code scan, but rather allows a user to move through (and perhaps erase) recorded memos (see Figure 2, step 104 and column 5, lines 4 to 12). Thus, the Raistrick patent does not teach what the Office alleges.

Moreover, the Raistrick patent is concerned with helping the visually impaired. One skilled in the art would not have been motivated to use such techniques in the context of an imaging system, such as that described in the Haneda patent, which uses thumbnails of images.

Thus, claims 17, 18, 37 and 38 are not rendered obvious by the Haneda and Raistrick patents for at least these additional reasons.

Accordingly, the appellants respectfully request that the Board reverse this ground of rejection of claims 9 and 28 under 35 U.S.C. § 103(a) as obvious over the Haneda patent in view of the Raistrick patent.

f.   **Claim 43 is not obvious under 35 U.S.C. § 103(a) over the Haneda patent**

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Claim 43 stands rejected under 35 U.S.C. § 103 as being unpatentable over the Haneda patent. The appellants respectfully request that the Office reconsider and withdraw this ground of rejection in view of the following.

The Office takes official notice that updating a database based on files deleted from a storage medium is well to known and that implementing this into the Haneda patent would have been obvious to those skilled in the art. The Office's motivation to combine the purported well to known database update is that it would make searching simpler by eliminating from the database directory, files that have been deleted (see Paper No.01/04/06, page 11).

First, even assuming, arguendo, that updating a database based on files deleted from a storage medium is well to known, and further assuming, arguendo, that one skilled in the art would have been motivated to combine this purported knowledge into the Haneda patent as proposed by the Office, claim 1 would still not be rendered obvious for the reasons discussed above. Since claim 43 depends from claim 1, it would similarly be non to obvious.

Second, even assuming, arguendo, that updating a database based on files deleted from a storage medium is well to known, the Haneda patent does not contemplate changing the image data written to the user disk. That is, it is not contemplated that the user will delete such image data from the user disk. Moreover, the laboratory storage is apparently intended to be an archival storage (and is not provided with both a unique volume label and a unique storage medium label, the unique storage medium label uniquely identifying the storage

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medium), and consequently, image file deletion from laboratory storage is also not contemplated. Accordingly, there would be no motivation to combine the purportedly well to known act of updating a database based on files deleted from a storage medium into the system described in the Haneda patent. Accordingly, claim 43 is not rendered obvious by the Haneda patent for at least this additional reason.
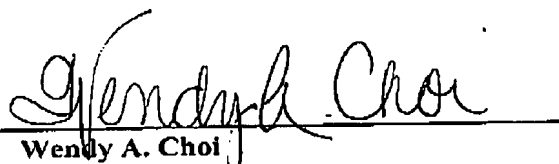
Accordingly, the appellants respectfully request that the Board reverse this ground of rejection of claim 43 under 35 U.S.C. § 103(a) as obvious over the Haneda patent.

Conclusions

Appellants request that this patent application be remanded to the Patent Office with an instruction to withdraw the rejections of the claims under 35 U.S.C. §§ 112, first paragraph, 102(e), and 103(a), and allow the appealed claims.

Respectfully submitted,

Date: **November 23, 2007**

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8.   CLAIMS APPENDIX

The following claims are involved in the present appeal:

1.   For use by a read/write machine, a method for assigning a unique label to a storage medium, the method comprising:

    a)   determining whether or not the storage medium has been assigned a unique volumene label and a unique storage medium label, the unique storage medium label uniquely identifying the storage medium;

    b)   if the storage medium has not been assigned a unique volume label and a unique storage medium label, then

        (i)   determining a unique storage medium label for the storage medium,

        (ii)   determining a unique volume label for the storage medium,

        (iii)   writing the unique volume label onto the storage medium, and

        (iv)   providing a command to generate a label based on the unique storage medium label, the label to be associated with the storage medium; and

    c)   updating a database based on files, if any, added to or deleted from the storage medium.

2.   The method of claim 1 further comprising:

    d)   synchronizing the database with a database on a device apart from the read/write machine.

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3.   The method of claim 2 wherein the read/write machine is a personal computer and the device is a handheld device.

4.   The method of claim 3 wherein the device is an untethered handheld device.

5.   The method of claim 1 wherein the read/write machine is a computer with at least one of (a) a floppy disk drive, (b) a CD ROM drive, (c) a ZIP drive, and (d) a DVD drive.

6.   The method of claim 1 wherein the label based on the unique storage medium label is a bar code label.

7.   The method of claim 1 wherein the act of determining a unique volume label is based, at least in part, on state information accessible to the read/write machine.

8.   The method of claim 7 wherein the state information is a count sequence.

9.   The method of claim 1 wherein the database includes records, each record including a first field having a value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium.

10.   A method of claim 1, further comprising:

    d)   accepting information read from a label associated with the storage medium without reading the storage medium;

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e) converting the accepted information into a database key;

f) requesting records from a database instance using the database key;

g) accepting records in response to the request; and

h) rendering information about the accepted records.

11. The method of claim 10 wherein the label associated with the storage medium is a bar code and wherein the information read from the label is accepted from a bar code scanner.

12. The method of claim 10 wherein the information about the accepted records rendered includes file names.

13. The method of claim 12 wherein the accepted information read from a label associated with the storage medium is read by a handheld device, and the information about the accepted records is rendered on the handheld device.

14. The method of claim 13 wherein the read label is converted into a database key by the handheld device, the records are requested from a database instance using the database key by the handheld device, and the records are accepted in response to the request by the handheld device.

15. A method for matching file parameters with one or more storage media, each of the one or more storage media having an associated label, the method comprising:

    a)   accepting one or more search parameters selected from a group of parameters consisting of (A) file name, (B) file size, (C) file author, and (D) file type;

    b)   generating a query based on the search parameters;

    c)   accepting one or more records returned in response to the query generated;

    d)   rendering information associated with each of the one or more records accepted, the information rendered being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted.

16.   The method of claim 15 wherein the labels are machine to readable labels, the method further comprising:

    e)   accepting information read from the machine to readable labels;

    f)   if the accepted information read from the machine to readable labels matches information associated with any one of the one or more records accepted, then generating a first indicator, said first indicator able to be perceived by humans.

17.   The method of claim 16 further comprising:

    g)   if the accepted information read from the machine to readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans.

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18. The method of claim 17 wherein the first indicator is a first audible sound, and the second indicator is a second audible sound.

19. The method of claim 15 wherein each of the labels include human to readable part, and wherein the information associated with each of the one or more records accepted corresponds to the human to readable part of the labels.

20. An apparatus for assigning a unique label to a removable storage medium, the apparatus comprising:

   a) means for reading files from and/or writing files to a removable storage medium;

   b) means for generating a label;

   c) means for determining whether or not the removable storage medium has been assigned a unique volume label and a unique storage medium label, the unique storage medoum label uniquely identifying the storage medium;

   d) means, if the storage medium has not been assigned a unique volume label and unique storage medium label, for

      (i) determining a unique storage medium label,

      (ii) determining a unique volume label,

      (iii) instructing the means for reading and/or writing files to write the unique volume label onto the storage medium, and

      (iv) providing a command to generate a label based on the unique storage medium label , to the means for generating a label; and

e)   a database, wherein the database is updated based on files added to or deleted

from the removable storage medium.

21.   The apparatus of claim 20 further comprising: f) means for synchronizing the

database with a database on a device apart from the apparatus.

22.   The apparatus of claim 21 wherein the device is a handheld device.

23.   The apparatus of claim 21 wherein the device is an untethered, handheld device.

24.   The apparatus of claim 20 wherein the means for reading files from and/or writing

files to a removable storage medium are at least one of (a) a floppy disk drive, (b) a

CD ROM drive, (c) a ZIP drive, and (d) a DVD drive.

25.   The apparatus of claim 20 wherein the label is a bar code label.

26.   The apparatus of claim 20 further comprising: f) state information, wherein the unique

volume label is determined, at least in part, based on the state information.

27.   The apparatus of claim 26 wherein the state information is a count sequence.

28.   The apparatus of claim 20 wherein the database includes records, each record

including a first field having a value associated with the unique volume label, and a

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second field having a value associated with a file stored on the removable storage medium.

29.   The apparatus of claim 20, further comprising:

    f)   means for reading a label associated with the storage medium without reading the storage medium;

    g)   means for accepting information read, by the means for reading, from a label associated with the storage medium;

    h)   means for converting the read label into a database key;

    i)   means for requesting records from a database instance using the database key;

    j)   means for accepting records in response to the request; and

    k)   means for rendering information about the accepted records.

30.   The apparatus of claim 29 wherein the means for reading is a bar code scanner, and wherein the label associated with the storage medium is a bar code.

31.   The apparatus of claim 29 wherein the information about the accepted records rendered includes file names.

32.   The apparatus of claim 29 wherein the means for rendering is a display.

33.   The apparatus of claim 29 further comprising:

    l)   the database.

34. The apparatus of claim 33 further comprising:

  m) means for synchronizing the database with a database maintained by a separate machine which created the storage medium.

35. An apparatus for matching file parameters with one or more storage media, each of the one or more storage media having an associated label, the apparatus comprising:

  a) a user input for accepting one or more search parameters selected from a group of parameters selected from a group of parameters consisting of (A) file name, (B) file size, (C) file author, and (D) file type;

  b) means for generating a query based on the accepted one or more search parameters;

  c) means for accepting one or more records returned in response to the query generated;

  d) means for rendering information associated with each of the one or more records accepted, the information rendered being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted, wherein the label is provided on the storage medium without storing it on the storage medium.

36. The apparatus of claim 35 wherein the labels are machine to readable labels, the apparatus further comprising:

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    e)   a label reader for reading information read from the machine to readable labels; and

    f)   an output means for generating a first indicator able to be perceived by humans if the accepted information read from the machine to readable labels matches information associated with any one of the one or more records accepted.

37.   The apparatus of claim 36 wherein the output means further generates a second indicator able to be perceived by humans if the accepted information read from the machine to readable labels does not match information associated with any one of the one or more records accepted.

38.   The apparatus of claim 37 wherein the output means is a speaker, wherein the first indicator is a first audible sound, and wherein the second indicator is a second audible sound.

39.   The apparatus of claim 35 wherein each of the labels include human to readable part, and wherein the information associated with each of the one or more records accepted corresponds to the human to readable part of the labels.

40.   The method of claim 1 wherein if the storage medium has not been assinged a unique volume label and a unique storage medium label then further,

    -    generating a label based on the unique storage medium label, and

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- fixing the generated label to the storage medium without storing it on the storage medium.

41. The apparatus of claim 20 further comprising means, if the storage medium has not been assigned a unique volume label and a unique storage medium label for

- generating a label based on the unique storage medium label, and

- fixing the generated label to the storage medium without storing it on the storage medium.

42. The method of claim 15 wherein the information rendered is related to the label associated with the storage medium storing one or more files identified with the one or more records accepted such that a suer or a scanner can distinguishe the storage medium including the label from other storage media.

43. The method of claim 1 further comprising:

d) updating the database based on files deleted from the storage medium.

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9.   **EVIDENCE APPENDIX**

No additional evidence is submitted in the Evidence Appendix.

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10. RELATED PROCEEDINGS APPENDIX

No related appeals or interferences are pending.